

AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P. O. Box 7599
Loveland, Colorado 80537-0599



ATTORNEY DOCKET NO. 10030747-1

ZFW
AF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): John F. Casey, et al.

Serial No.: 10/600,600

Examiner: Bret P. Chen

Filing Date: June 19, 2003

Group Art Unit: 1762

Title: METHODS FOR DEPOSITING A THICKFILM DIELECTRIC ON A SUBSTRATE

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Sir:

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on 03/16/2005. This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new grounds of rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 50-1078.

Respectfully submitted,

John F. Casey, et al.

By

Gregory W. Osterloth
Attorney/Agent for Applicant(s)

☒ I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450.

Date of Deposit: May 16, 2005

OR

☐ I hereby certify that this paper is being facsimile transmitted to the Commissioner for Patents on the date shown below.

Date of Facsimile:

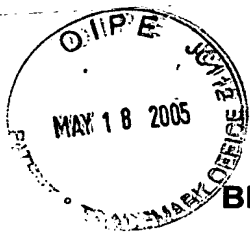
Typed Name: Gregory W. Osterloth

Signature: 

Reg. No. 36,232

Date: May 16, 2005

Telephone No. (303) 291-3200



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appl. No.	:	10/600,600	Confirmation No. 5492
Appellant	:	John F. Casey, et al.	
Filed	:	June 19, 2003	
TC/A.U.	:	1762	
Examiner	:	Bret P. Chen	
Docket No.	:	10030747-1	

Board of Patent Appeals and Interferences
United States Patent and Trademark Office
PO Box 1450
Alexandria, Virginia 22313-1450

REPLY BRIEF

Dear Sir:

This Reply Brief is submitted in response to the Examiner's Answer dated
March 16, 2005.

Argument

1. Response to Examiner's position on whether claims 1-8, 12 and 14-17 stand rejected or allowed.

Appellants accept the Examiner's updated claim status. This issue is now moot..

2. Response to Examiner's position on whether claims 9-11, 18 and 20 should be rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

With respect to MPEP 608.01(v), Appellants concede that the Office's trend has been to construe this section's use of "application" as implying "specification". However, this being the case, the MPEP's only guidance on the use of a trademark, trade name, or other proprietary product identifier in a claim is the MPEP's brief cite to *Ex Parte Simpson* – a case that some Examining Groups interpret as standing for a blanket prohibition on the use of trademarks, trade names or other product identifiers in claims. Appellants believe this position is not supported by *Simpson*.

In *Ex Parte Simpson*, the Examiner rejected some of Simpson's claims because of their reliance on the trademark Hypalon, which the Examiner believed made the claims indefinite. However, although the Board sustained the Examiner's indefiniteness rejection, Appellants can find no statement by the Board that a trademark, trade name or product identifier makes a claim "*per se*" indefinite. Rather, the Board states:

... A patent applicant has an obligation that is imposed by 35 U.S.C. 112, second paragraph, to employ claim terminology which is definitive of what the public is not free to use, and ***use of a trademark in the manner employed by appellant*** has resulted in claims which fail to meet this obligation in our opinion.

Ex Parte Simpson, 218 USPQ 1020 (1982). Emphasis added.

It therefore seems to Appellants that the Board did not intend *Simpson* to stand for the blanket proposition that the use of a trademark in a claim makes the claim indefinite. Rather, it seems to Appellants that the Board believed Simpson's particular trademark use made his claims indefinite. Thus, in response to the Examiner's assertion that Appellants have not provided any evidence to support their proposition that *Simpson* is "a rather unique case", Appellants simply point to *Simpson's* above holding, which is a holding based on the specific facts of that case.

Given that the MPEP is largely silent on the use of trademarks in claims, and given that the holding in *Simpson* is fact-specific, Appellants refer the Board to their past "unpublished opinion" in *Ex Parte Jerry Kitten*. As the Examiner correctly notes, the *Kitten* opinion is nonbinding. However, Appellants believe the opinion sheds light on how the Board views its *Simpson* decision. The opinion also shows that the Board has not construed *Simpson* in the same manner that some of the Office's Examining Groups have. That is, as with *Simpson*, *Kitten* stands for the proposition that the ultimate issue is whether a claim is "definite", in accordance with 35 U.S.C. 112, second paragraph; and a claim cannot be summarily held indefinite merely because it recites a trademark.

Appellants assert that the limitations "KQ dielectric" and "KQ CL-90-7858" are definite. Appellants admit that "KQ dielectric" is a trademark. However, Appellants assert that the products covered by this trademark are limited to a defined group of products. That is, as published on Heraeus Cermalloy's website, and in published papers, KQ dielectrics are glass dielectrics having a very low loss tangent (around 10^{-4}) and dielectric constant (around 3.9).

With respect to "KQ CL-90-7858 dielectric", Appellants admit that this identifier may have some trademark value. However, its primary purpose is to serve as an identifier of a specific product having a specific composition. It does not identify a group of products, and the product identified thereby is not reasonably subject to change (see Appellants' arguments in their Appeal Brief).

Of further note, and as discussed in Appellants' Appeal Brief, the current issue is distinguishable from the trademark use at issue in *Simpson* because, in this

Appl. No. 10/600,600
Appeal Brief dated May 16, 2005
Reply to Examiner's Answer of Mar. 16, 2005

case, the trademarks or product identifiers do not appear in independent claims, but rather appear in dependent claims, as further narrowing limitations on claims that the Examiner has already acknowledged are "definite" in scope.

Respectfully submitted,
DAHL & OSTERLOTH, L.L.P.

By:



Gregory W. Osterloth
Reg. No. 36,232
Tel: (303) 291-3200